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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,592	01/16/2004	Wilhelm Frank	071308.0523	3283

31625 7590 05/09/2007  
BAKER BOTTS L.L.P.  
PATENT DEPARTMENT  
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AUSTIN, TX 78701-4039

EXAMINER
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WOLFE, DEBRA M

ART UNIT	PAPER NUMBER
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3725

MAIL DATE	DELIVERY MODE
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05/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/758,592

Applicant(s)

FRANK ET AL.

Examiner

Debra Wolfe

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on February 28, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 7 is/are rejected.
- 7) ☒ Claim(s) 15-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/743183.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |



## **FINAL REJECTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the prestressing device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (US Patent # 2,675,022) in view of Jelinek et al (US Patent # 3,656,769). Bohn discloses a method for producing a compensation collar for an injection valve comprising the steps of providing an injection valve without an insertable piezoactor, inserting a compensation collar (10a) having a thickness and deforming the compensation collar (10a) to a thickness by inserting a prestressing device (10) into the injection valve. It is noted that when the lower valve body (10) is inserted into the injection valve it will inherently apply a pressure onto the compensation collar and therefore a deformation will occur. Furthermore, Applicant's prestressing device does not distinguish over the use of a lower valve body to plastically deform a compensation collar. Bohn discloses the invention substantially as claimed except for wherein the compensation collar is plastically deformed. However, Jelinek et al teaches of using a plastically deformable compensation collar (10, 16, 17) for the purpose of establishing an effective fluid seal to prevent leakage. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Bohn to have a plastically deformable compensation collar as taught by Jelinek in order to establish an effective fluid seal to prevent leakage.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (US Patent # 2,675,022) in view of Jelinek (US Patent # 3,656,769). Bohn in view of Jelinek disclose the invention substantially as claimed except for wherein the compensation collar consist of a



flowable material such that it begins to flow during the compression and thereby is plastically deformed. However, the Examiner takes official notice that it is known to one of ordinary skill in the art to provide a compensation collar consisting of a flowable material such that the material flows during the compression process in order to allow the collar to deform thereby creating a proper seal. Therefore, it would have been obvious to one of ordinary skill in the art to have a compensation collar consisting of a flowable material in order to allow the material to flow during the compression process to create a proper seal.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (US Patent # 2,675,022) in view of Jelinek et al (US Patent # 3,656,769) as applied to claim 2 above, and further in view of Sumida et al (US Patent # 5,630,400). Bohn in view of Jelinek discloses the invention substantially as claimed except for wherein the compensation collar is made of a soft iron or copper. However, Sumida et al teaches of providing a copper gasket within an injection valve for the purpose of providing an efficient seal. Therefore, it would have been obvious to one of ordinary skill in the art to modify the compensation collar (10a) of Bohn to be made of a copper material as taught by Sumida et al in order to provide an efficient seal.

#### ***Pertinent Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent # 6,745,956 to Bantle et al discloses the method of plastically deforming a copper sealing disk, however the filing date of this patent is 4 months after the priority date of the current application.



***Response to Arguments***

Applicant's arguments with respect to claims, 2, 3 and 7 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

Claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Wolfe whose telephone number is (571) 272-1904. The



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examiner can normally be reached Monday - Thursday 7am - 4:30pm with alternating Friday 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra Wolfe  
Examiner  
Art Unit 3725

  
DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700